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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,020	09/15/2003	Barry Bronson	10008364-2	2739

7590

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HEWLETT-PACKARD COMPANY  
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EXAMINER

PHAM, HAI CHI

ART UNIT      PAPER NUMBER

2861

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/664,020

Applicant(s)

BRONSON, BARRY

Examiner

Hai C Pham

Art Unit

2861

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-41 is/are allowed.
- 6) ☒ Claim(s) 42 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Allowable Subject Matter***

1. The indicated allowability of claims 34 and 37, which are now rewritten as independent claims 42 and 43, respectively, is withdrawn in view of the newly discovered references to Kitahara et al. (U.S. 6,102,800) and Koike (JP 5-225570). Rejections based on the newly cited references follow.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aihara et al. (JP 2000-173238) in view of Kitahara et al. (U.S. 6,102,800).

Aihara et al., an acknowledged prior art, discloses an optical disc (1) comprising a thermally sensitive layer that changes color when heated for forming a label (3), one or more alignment marks (3a) pre-printed on the optical disc (see abstract).

Aihara et al. fails to teach the pre-recorded data containing disc information wherein the embedded data includes licensing information.

Kitahara et al. discloses an information storage medium provided with program software, a label and prerecorded data in the TOC (Table of Contents) area related to

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the trademark and information requiring judgment as to whether is authentic or counterfeit.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include pre-recorded data related to the licensing information in the device of Aihara et al. since Kitahara et al. discloses this as a common practice used in the industry for protecting the proprietary data distributed to the users.

4. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aihara et al. in view of Koike (JP 5-225570).

Aihara et al. discloses all the basic limitations of the claimed invention except for the disc storage medium being provided with a test printing area.

Koike discloses an optical disc provided with a trial writing area (4) formed on an inner peripheral side of the rewritable area (2) such that an optimum recording light quantity can be determined (see Abstract).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include a trial writing area in the optical disc of Aihara et al. as taught by Koike for the purpose of determining the optimum light quantity for the recording operation as suggested by Koike.

***Allowable Subject Matter***

5. Claims 22-41 are allowed.

The following is an examiner's statement of reasons for allowance: claim 22 is patentable over the prior art patents and printed publications because the optical disc comprises a thermally sensitive layer that changes color when heated for creating a thermal media label, one or more alignment marks pre-printed on the optical disc, and pre-recorded data containing embedded disc information about the optical disc including printing characteristics of the thermally sensitive layer to control creating the thermal media label. The combined limitations are not taught by the art of record alone or in combination.

Claims 40 and 42 are allowable because the optical disc further included pre-recorded data describing pattern of colors and gray scale information, respectively. The combined limitations as recited in each of the above claims are not taught by the art of record alone or in combination.

Claims 23-39 are allowed because they are directly or indirectly dependent from claim 22 above.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Allowable Subject Matter***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C Pham whose telephone number is (571) 272-2260. The examiner can normally be reached on M-F 8:30AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HAI PHAM  
PRIMARY EXAMINER

July 7, 2004